

REMARKS

The present invention is directed to a method for producing self-adhesive molded silicone-resin based parts that overcomes the problems associated with adhering a silicone part to its substrate by adhesive bonding or by overmolding, in that the overall time required to produce the part is reduced. The Examiner's attention is directed to the two processes of premolding and overmolding, as described on pages 1-2 in the Specification. Both of these processes are problematic in that **they require too much time** to produce a self-adhesive silicone-resin based part. The combined references cited by the Examiner do not provide guidance on how best to solve this problem.

Therefore, the rejection of claims 4-16 under 35 U.S.C. § 103(a) as being unpatentable over the two processes described in the Specification (overmolding and premolding processes, pp. 1-2) in view of Parker (US 4,973,371), Clark (US 4,351,686), and Waldenberger (US 4,839,206) is traversed. The Office's prima facie case is flawed, as there is no adequate reason of record why it would combine the two admitted processes with selected portions of the disclosures of Parker, Clark, and Waldenberger. Why is it obvious to combine some aspects of the overmolding process with some aspects of the premolding process with the selected disclosures of Parker, Clark, and Waldenberger? The Office's reasoning is that "it would have been obvious to one of ordinary skill in the art." This is not permissible, especially when there is no specific motivation or suggestion in the combined references to develop a method as claimed herein. Thus, it is requested that the Examiner reconsider the rejection in view of the following comments.

As noted above, Applicant's claimed invention solves a problem that is inherent in both the overmolding and the premolding processes (pages 1-2). The most notable time-consuming aspects of the premolding process are related to the required cure time (p. 1, ll.

26-27) and that a specific tool is occupied during the process of curing (p. 1, ll. 27-29). The overmolding process suffers from time-consuming steps, in that time must be allowed for the adhesion primer layer to dry, and an even longer time must be allowed for the curing to take place (p. 2, ll. 5-8). It is not obvious, based on these two processes, to extract selected elements from three other disclosures, namely Parker, Clark, and Waldenberger, in order to solve these problems. Yet the Office has constructed an opinion based on that which is recited in the specification and a collection of three disclosures, two of which (Parker and Waldenberger) are completely unrelated, while the third (Clark) is only related in that Clark describes an article that has silicon-atoms. How can the Office justify this rejection without an adequate reason to combine them? It cannot. Why? Hindsight may be 20/20, but its application to an statutory rejection is simply impermissible.

For example, Parker seeks solutions to an entirely different set of problems, as reproduced in the following text (col. 1, ll. 18-27):

The problem with wax release or foam precursor release system is that they require use of expensive release chemicals in the production process. Further, use of wax release agents can cause wax contamination of a subsequent paint process. Such contamination can result in poor adhesion of paint coatings on the foamed part.

Another problem with release systems is that the release chemicals can cause poor foam adhesion to vinyl shells contaminated by such chemicals.

Indeed, inspection of the following (col. 1, ll. 58-62):

An object of the present invention is to provide an improved process for manufacturing foam parts which will eliminate the need for mold lid release chemicals and which will concurrently provide a post adhesion surface on the mold part.

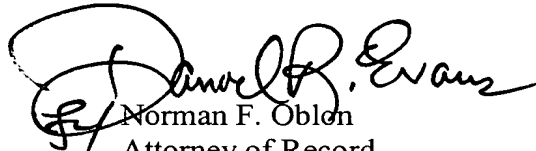
shows that Parker does not address these issues at all. Parker's disclosure does not contemplate how time-consuming it can be in order to cure silicone-resins in the presence of silicone-based adhesives. How can the Office justify including this reference, or for that

matter the disclosures of Clark and Waldenberger, into the overall analysis? Inspection of the Official Action shows that the Office has not found a specific recitation, and thus a reason, in any of the references that would provide a motivation to combine these references. Instead, it would appear that the Office has attempted to reconstruct the elements of the claimed invention without specific guidance from the references at hand. Applicants note that the Office has erroneously applied a two-pronged analysis that includes both an "obvious-to-try" and an attempt to construct a claimed method by employing "hindsight reasoning." It is requested that the Examiner reconsider and withdraw this rejection, especially in view of the guidelines as put forth in MPEP §§ 2142 and 2144, and throughout MPEP 2100.

Applicants submit that the present application is in a condition for allowance. Early notification to this effect is respectfully requested.

Respectfully submitted,

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